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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,137	01/27/2000	Takayuki Watanabe		9482

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10/31/2002

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EXAMINER

MAI, HAO T

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 10/31/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/492,137

Applicant(s)

WATANABE ET. AL.

Examiner

MAI, H.

Art Unit

1761

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 5/29/20. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: SEE ATTACHED PAPER
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONEClaim(s) objected to: NONEClaim(s) rejected: 1-10, 12, 15

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

ATTACHMENT TO ADVISORY

Response to Remarks

Applicants pointed out that the last Office action (Advisory Action) failed to indicate whether or not the amendment after final filed on April 29, 2002 (Paper No. 10) have been entered.

Review of the record indicates that the appropriate block of item 7 of the Advisory action was not selected. The record show however, that the amendment above mentioned after final was indeed entered. A copy of the previous Advisory action showing the selected box of item 7 and the rejected claims is attached hereto. Any delays and confusion is deeply regretted.

With regard to applicants' argument related to the use of the "consisting essentially of" language in the instant claims intended to allegedly exclude components which could materially affect the basic nature or characteristic of the instant claimed powder composition, namely, the glycacarbamate and glycaurea of Vermeer and the rice of Nakamura et al.


In response to applicants' argument, it is well settled that the use of the phrase "consisting essentially of", preceding a list of ingredients in a composition claim, typically means that the composition is open to unlisted ingredients which do not materially affect the basic and novel properties or characteristics of the composition. PPG Industries v. Guardian Industries Corporation, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998).

While the Vermeer and Nakamura et al. compositions certainly contain a number of ingredients not listed in the rejected claims, this along does not forestall a finding of anticipation. As explained previously, the claim language under consideration is open to

unlisted ingredients which do not materially affect the basic and novel properties of the instant claimed composition.

Significantly, applicants' have not shown that any of the Vermeer and Nakamura et al. ingredients, particularly the glycacarbamate and glycaurea, which are not listed in the rejected claims would materially affect the basic and novel properties or characteristics of the instant claimed composition. Regarding this point, it is emphasized that it is applicants' burden to show that such unlisted ingredients are excluded by the "consisting essentially of" claim language. This allocation of burden is particularly appropriate where, as here, the specification does not make clear what is regarded as constituting a material change in the basic and novel characteristic of the disclosed and claimed invention.

The declaration under 37 C.F.R. 1.132 filed on April 29, 2002 is insufficient to overcome the rejection of claims 1-4, 12, and 14-15 based upon anticipation as set forth in the last Office action for the following reasons: it was untimely filed (MPEP 716.01); the facts presented are not germane to the rejections at issue; and showing is not commensurate in scope with the claims, see above explanation.


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